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--42. (New) The roll of claim 1, wherein the coating has a thickness between about 0.1 mm to about 0.3 mm.--

--43. (New) The charge donor roll of claim 14, wherein the coating has a thickness between about 0.1 mm to about 0.3 mm.--

--44. (New) The method of claim 27, wherein the coating has a thickness between about 0.1 mm to about 0.3 mm.--

REMARKS

Claims 1-44 are pending. By this Amendment, claims 7, 20 and 34 are amended, and claims 42-44 are added to recite features supported in the specification on page 15, lines 8-9. Rejoinder of claims 27-41 is respectfully requested.

Applicants appreciate the courtesies extended to Applicants' undersigned representative and Examiner Rudasill during the December 3, 2002 interview. The points discussed during the interview are incorporated in the remarks below and constitute Applicants' record of the interview.

Applicants gratefully acknowledge that claims 3, 4, 6-10 and 13-22 contain allowable subject matter. However, the for the following reasons, Applicants respectfully submit that claims 1, 2, 5, 11, 12 and 23-26 are also allowable. Thus, none of claims 3, 4, 6-10 or 13-22 have been rewritten in independent form.

The Office Action rejects claim 1 under 35 U.S.C. §112, second paragraph as being indefinite, citing *Ex parte Slob*, 157 USPQ 172. Applicants respectfully traverse the rejection.

Claim 1 recites a roll, comprising a core, and a coating comprising a glass material provided over the core, wherein the glass material can be electrically charged and discharged. Applicants assert that a roll having a core and a coating provide a defined structure, and that "a glass material" is commonly understood as an amorphous solid, and therefore

unambiguous in meaning. While the court in *Slob* rejected the composition “a liquefiable substance” as vague, the term “glass” cannot properly be so characterized.

Applicants further assert that the material condition of electrical chargeability and dischargeability clearly indicates acquisition and release of electric charge, whether positive or negative. The meaning of the claim is therefore clear under MPEP §2173.02, which admonishes the Examiner to “allow claims which define the patentable subject matter with a reasonable degree of particularity and definiteness” (emphasis original). Withdrawal of the rejection under 35 U.S.C. §112, second paragraph is respectfully requested.

The Office Action rejects claims 1, 2, 5, 11 and 12 under 35 U.S.C. §102(b) as anticipated by United States Patent 5,697,029 to Saitoh et al. Applicants respectfully traverse the rejection.

Saitoh does not disclose a roll comprising a core and a coating comprising a glass material provided over the core, wherein the glass material can be electrically charged and discharged, as recited in claim 1. Specifically, Saitoh fails to teach or suggest a glass coating, but instead includes forming an unspecified coating of between 0.3 and 0.32  $\mu\text{m}$  thick using a quartz target. See col. 4, line 66 - col. 5, line 4. Not only does Saitoh identify the silicon dioxide as being the target, i.e., the source material for the sputter-formed coating rather than the coating, but also the quartz form of the material presents a crystalline structure, rather than an amorphous glass, as claimed. Nowhere does Saitoh teach anything about the form or structure of the coating formed by a sputtering process using quartz as the sputter target.

In addition, this coating in Saitoh demonstrated unsatisfactory results for printing purposes. In particular, Saitoh cites that “no clear print image” was obtained from the developing roller with a sleeve formed according to Comparative Example 2. See col. 5, lines 30-36 of Saitoh. Thus, Saitoh teaches away from Applicants’ claims, because Saitoh clearly teaches that this Comparative Example 2 is non-operative.

Also, Saitoh makes no mention of the coating formed according to Comparative Example 2 being electrically chargeable or dischargeable, as recited in claim 1. While the Office Action asserts that electrical chargeability or dischargeability would be inherent, such properties typically require doping of particular electrically conductive materials, such as metals. Because Saitoh does not teach or suggest at such chargeable or dischargeable properties the coating formed according to Comparative Example 2, Applicants respectfully submit that such teaching can only be obtained by hindsight from reading Applicants' disclosure.

Instead, Saitoh teaches a developing roller having a magnet roller and a cylindrical sleeve, with a coating formed on the outer surface of the sleeve. The coating is composed primarily of a metal, alloy, metal nitride, metal oxide, metal carbide or metal sulfide. The coating may also include an organic component. See col. 3, lines 8-28 of Saitoh. A glass material, on the other hand, typically comprises silica and/or soda, which generally represent inorganic non-metal compounds.

Further, glass material, as recited in claim 1, is not inherently chargeable or dischargeable, as such inorganic compounds typically constitute electrical insulators. Saitoh provides no suggestion of such properties for a glass coating, and discourages motivation by disclosing resistivity above  $0.1 \Omega\text{cm}$ , thereby suggesting electrical properties considered counterintuitive for purposes of chargeability and dischargeability.

Further, while Saitoh describes a coating having a thickness of  $0.3$  to  $0.32 \mu\text{m}$  in Comparative Example 2, this coating was about three orders of magnitude thinner than featured in Applicants' new claims 42-44, in addition to failing to satisfy Saitoh's purposes. Saitoh further teaches that a coating thicker than about  $0.32 \mu\text{m}$  would be non-operative. See col. 4, lines 66-67 of Saitoh.

Thus, Saitoh does not teach or disclose all the features of claims 1 and 27.

Accordingly, Saitoh fails to anticipate the subject matter of claims 1-44 under 35 U.S.C.

§102(b). Applicants respectfully request withdrawal of the §102 rejection of claims 1, 2, 5, 11 and 12 as anticipated by Saitoh.

For at least the reasons set forth above, Applicants respectfully submit that the application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-44 are earnestly solicited.

Should the Examiner believe that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,



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Attachment:  
Appendix

Date: December 31, 2002

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